

Attorney Docket No. LANG-30273
Application No. 10/734,409
Amendment and Response

Remarks

Claims 1-71 are pending in the application. Claims 14, 16-22, 39, 41-47, 56-57, 65-66 have been withdrawn from consideration. Claims 1, 23, 24, 26, 36, 48, 49, 51, 52, 53, 55 and 58 have now been amended. New claims 72-74 have been added. Claims 25, 27 and 50 have been canceled.

I. Rejection Under 35 U.S.C. §112, Second Paragraph

Claims 23-25 and 48-50 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

With respect to claims 23, 24, 48 and 49, Applicant has amended these claims to provide structural features that should overcome the Examiner's objections with respect to these claims. Claims 25 and 50 have been canceled.

Applicant respectfully submits that the rejections under 35 U.S.C. §112, second paragraph, have been addressed and the rejections should now be withdrawn.

II. Rejections Under 35 U.S.C. §102(b)

The Examiner has rejected claims 1-4, 6, 7, 11, 13, 15, 23-29, 31, 32, 36, 38, 40, 48-50, 58, 60-64, 67, 69 and 70 as being anticipated under 35 U.S.C. §102(b) by Borden (U.S. Patent No. 5,090,138). The Examiner has further rejected claims 1, 2, 11, 12, 15, 23-27, 36, 37, 40, 48-50, 58 and 60-64 as being anticipated under 35 U.S.C. §102(b) by Rullier (U.S. Patent No. 5,369,897); and claims 1, 2, 11, 12, 15, 23-27, 36, 37, 40, 48-50, 58 and 60-64 under 35 as being anticipated under 35 U.S.C. §102(b) by Borel (U.S. Patent No. 5,909,885).

An invention is said to be "anticipated" only if each and every element set forth in the claim is found, either expressly or inherently, within a single prior art reference. *Verdegall Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that each of the references Borden, Rullier and Borel each fail to disclose each and every element of Applicant's claimed invention and thus fail to anticipate Applicant's presently pending claims.

Applicant's invention is shoe support system for supporting the ankle of a foot. The shoe support system is used to facilitate prevention of inversion and eversion

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movement of the ankle, which can lead to serious injury. In particular, the shoe support system may be incorporated or included in the shoe itself. The support system is particularly useful in athletic shoes of various types and may replace the athletic tape or "spatting" that is wrapped around the ankle and shoe to provide support. Because the support system is intended to be incorporated into a common shoe, it is lightweight, compact and non-obtrusive.

In contrast, the device of Borden is a spring shoe device that is quite bulky and cumbersome in comparison to Applicant's invention. The device of Borden is more closely related to a therapeutic device. In the Borden device, the heel socket 12 has a pair of hinge ears 24 that pivotally couple to a calf member 26 of shin brace 14 at ankle hinge 16.

Rullier is directed toward a bulky ski boot that utilizes a heel counter 12 that is attached to a jointed collar by joint 14, which overlays the wearer's ankle.

Borel shows an inline skate boot 5, which is also quite bulky, and that utilizes a stiffener 12 around the heel and rear portion of the boot and is coupled at journal 19 to a journalled collar 13. As can be seen, the stiffener 12 and collar 13 are positioned over the wearer's ankle.

Applicant's claimed support system, as claimed in claim 1, utilizes a back inliner, coupling and sole inliner that do not extend over the ankle of the foot. Claim 1 has been specifically amended to specify this. Support for this is found in Figure 2, where it is shown that the sole inliner 120, the back inliner 160 and coupling 140 do not extend anywhere near the ankle, and for instance, at paragraph 0043, where it is described that the back inliner conforms to the back of the foot, namely the Achilles tendon. This is a significant distinction from the devices of the cited prior art. In each of the devices of the cited prior art, the ankle is covered by the rigid support components, which can create a pressure point, where rubbing or abrasion on or over the ankle can occur. In fact, pivoting or hinging of the devices of the prior art occurs directly over the ankle in the prior art.

In Applicant's device, the support elements do not overlay or extend over the ankle of the foot. Thus, there is no pressure exerted on the ankle while the device is being worn. Prevention of inversion and eversion of the ankle, however, is still

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facilitated through Applicant's support system. This design also makes Applicant's support system non-obtrusive, compact, and lightweight and readily incorporated into a conventional shoe, such as an athletic shoe. For at least this reason, newly amended independent claim 1 should be allowed, as well as those claims depending from it. Independent claims 26, 51 and 58 include similar limitations, which have been added by amendment, including those claims that depend from them, and should be allowed as well for the same reasons.

Dependent claim 2 calls for the coupling to be positioned adjacent to the heel of the foot. Claims 26 and 51 have also been amended to specify that the coupling is located at the heel of the foot. Claim 58 also requires that the back inliner and sole inliner be coupled generally at the heel of the foot. This provides superior strength to the support device while minimizing its size. This is not taught, shown or suggested in the cited prior art. In complete contrast, the device of Borden has a heel opening or pocket 22 for receiving the wearer's heel (col. 4, lines 51-55). It would thus be impossible for the device of Borden to meet this claim limitation and in no way could the members 38 and ankle hinge 16 be considered as being located at the heel of the foot. Furthermore, modification of Borden to provide this feature would destroy the function and purpose of the spring shoe device, as a pocket or opening 22 would no longer be provided for receiving the wearer's heel.

Likewise, the collar 13 of Rullier is coupled to the counter 12 at joint 14, which is located at the ankle and not at the heel, as required in Applicant's claims. And the collar 13 of Borel is also coupled to the stiffener 12 at the journal 19, which is also positioned over the ankle and not at the heel. Accordingly, claims 2, 26, 51 and 58, and those claims depending from them, should be allowed for this additional reason as coupling of the back inliner and sole inliner at or adjacent to the heel is not shown, taught or suggested by the prior art. These references thus fail as anticipatory references with respect to these claims. Accordingly, the rejection of claims 2, 26, 51 and 58 should be withdrawn.

Furthermore, claim 51 specifies that the back inliner is movably coupled to the sole inliner with the coupling, which is defined as being located generally at the heel of the foot. No such movable coupling located at the heel is shown in the cited prior art. For each of the references of Borden, Rullier and Borel, the devices are hinged or

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pivotal at or around the ankle. Nowhere is it taught, shown or suggested that hinged or pivotal movement is provided at the heel of the foot, as is the case with Applicant's support system. For this additional reason, independent claim 51, as well as those claims depending from it, should be allowed. New claims 72, 73 and 74 include similar limitations and should be allowed for the same reasons as claim 51.

Claim 59 was rejected based upon Borel. Claim 59 requires that the sole inliner and back inliner be integrated as one piece. The Examiner refers to the text of col. 3, lines 45-60 and states that the basing coupling means may be integrally formed. This, however, does not disclose a sole inliner and back inliner being integrated as one piece, as is required in Applicant's claim 59. It is only described in the text that the return member 100 may be integral with "one of the elements." Applicant submits that this does not constitute the sole inliner and back inliner being integrated as one piece. The Examiner refers to the stiffener 12 and collar 13 as being equivalent to the sole inliner and back inliner. From the disclosure of Borel, these are not formed as one piece. Accordingly, claim 59 should be allowed for this additional reason.

For all of the above reasons presented above, Applicant submits that none of the references of Borden, Rullier or Borel anticipates Applicant's presently pending claims. Accordingly, the rejections of Applicant's claims on this basis should be withdrawn.

III. Rejections Under 35 U.S.C. §103

The Examiner has rejected pending claims 4, 5, 29, 30, 67, 70 and 71 as being obvious under §103(a), based upon the reference Borden in combination with McDonald (U.S. Patent No. 5,319,869) or Aveni (U.S. Patent No. 5,467,537). Claims 8, 9, 33, 34, 51, 52, 54 and 55 were rejected as being obvious under §103(a) based upon Borden in view of Monti (U.S. Patent No. 5,992,057), with claims 10 and 35 being rejected further in view of McDonald or Aveni. Claims 8, 33, 51 and 55 were also rejected under §103(a) based upon Rullier in view of Monti.

In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP 2143.03.

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With respect to those rejections under §103(a) of Applicant's pending dependent claims, Applicant submits that in view of the amendments made to the independent claims and the remarks presented above with respect to the rejections under §102, that the cited combinations fail to teach or suggest each of Applicant's claim limitations even when combined. The rejections under §103(a) should be withdrawn.

IV. Conclusion

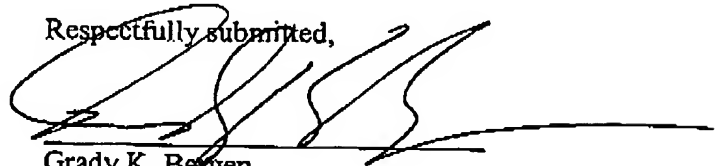
In view of all of the reasons presented above, Applicant submits that the application is in a condition for allowance. Favorable action is therefore respectfully requested.

No fees are believed necessary for this response. This response is being submitted within three months from the date of the office action. If any extension of time is believed necessary, however, such extension is hereby requested. If any fees are deemed necessary for the continued prosecution of the present application, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-1899.

Please contact the undersigned at the address or telephone number listed below should there be any questions, or if contacting the undersigned would expedite or aid the examination or prosecution of this application.

Date: February 6, 2006

Respectfully submitted,



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